

REMARKS

The present reply is responsive to the Office Action dated March 23, 2005. Claims 1-38 were rejected. Claims 1, 3 and 4 have been amended. No new matter is added by these amendments. Claim 2 has been cancelled. Therefore, claims 1 and 3-38 are presented for the Examiner's consideration in view of the following comments.

As an initial matter, formal drawings were submitted on June 7, 2004. However, the Office Action does not address whether the drawings have been accepted. Therefore, applicants respectfully request acceptance of the formal drawings in the next Office Action.

Claim 1 was rejected as being anticipated by U.S. Patent No. 2,191,701 ("Wood"). Applicants respectfully traverse the rejection.

Wood discloses a display apparatus having an adjustable bracket. (See FIG. 1.) Adjustable bracket 13 includes a flattened arm 14 having a supporting flange 17 and inwardly extending lugs 19 and 25, which are received by slots 12 on either side of a vertical pilaster or column 10. (See pg. 2, col. 1, lns. 50-62; see also FIG. 1.)

Applicants have amended claim 1 to include the limitations of dependent claim 2. As amended, claim 1 now requires a "wall mounting assembly for supporting a mounting device and adapted to engage a slat wall having an upper section and a lower section, the wall mounting assembly comprising: a main body; a mount attached to the main body and adapted to receive the mounting device; a first clip assembly attached to the main body and remote from the mount, the first clip assembly including an upper clip and a lower clip, the upper clip being engageable with the upper section of the slat wall, and the lower clip being engageable with the lower section of the slat wall; and a second clip assembly attached to the main body and remote from

the mount, the second clip assembly including an upper clip and a lower clip, the upper clip being engageable with the upper section of the slat wall, and the lower clip being engageable with the lower section of the slat wall; wherein the second clip assembly is spaced apart from the first clip assembly, and at least one of the upper clips or the lower clips of the first and second clip assemblies are adjustable."

The *Wood* apparatus does not teach or suggest all of the limitations required by independent claim 1. Thus, the rejection based on *Wood* should be withdrawn for at least this reason.

Claims 11-13 were rejected as being obvious over *Wood* in view of U.S. Patent No. 5,255,803 ("*Pavone*"). Applicants respectfully traverse the rejection.

As indicated above, *Wood* does not teach or suggest all of the limitations of currently amended claim 1. Notwithstanding the differences between claim 1 and the cited art, dependent claims 11-13 are also patentable for at least the following reasons.

Applicants respectfully submit that *Wood* and *Pavone*, taken alone or in combination, neither disclose nor suggest the wall mounting assemblies of claims 11, 12 or 13. Indeed, as will be demonstrated below, the Examiner's rejection should be withdrawn for two reasons: (1) the combination does not result in the claimed invention; and (2) there is no motivation to combine the references to arrive at the invention.

As to the first requirement, the technical teachings of *Wood* and *Pavone* are such that their combination would not result in the claimed invention. *Wood* neither teaches nor suggests a bushing in the openings of the mount of claim 11, a locking mechanism for arresting rotation of the mounting device within the opening as in claim 12, or a set screw adapted to

threadedly engage a hole in the mount and to engage the bushing as in claim 13. An attempt was made in the Office Action to remedy this substantial deficiency by relying on Pavone.

Pavone discloses a merchandising system having a freestanding base assembly 2 and an upright frame assembly 3, which includes a pair of upright frame members 31 and 32. (See FIG. 1; see also col. 4, lns. 31-45.) According to Pavone:

The nature of the upright frame members 31 and 32 and the horizontal frame member 3 having been described, their assembly to the base 2 is accomplished in the following manner. Upright frame member 31 is mounted on base 2 with the upstanding base lug 9 located within the rectangular socket 54 of upright frame member 31. The sidewall 36 of the rectangular portion 34 of upright frame member 31 is provided with a perforation 63 (see FIG. 6) coaxial with the perforations 10 and 11 in the upstanding base lug 9. This enables a set screw 64 to be threadedly engaged in bushing 12. The set screw is tightened until its forward end passes through the perforation 11 of the base lug 9 and engages the inner surface of wall portion 38 of the rectangular part of upright frame member 31. The wall portion 36 of the rectangular part of upright frame member 31 is provided with a second perforation 65 (see FIG. 5) which is coaxial with the perforations 13 and 14 near the upper end of the base lug 9. This enables the engagement of a set screw 66 in bushing 15. The set screw 66 is tightened until its forward end passes through the perforation 14 in the base lug 9 and engages the inside surface of the wall 38 of the rectangular part of upright frame member 31. Thus, upright frame member 31 is mounted on base lug 9 and is removably affixed thereto by the set screws 64 and 66. It will be understood that the upright frame member 32 will be similarly mounted on the upstanding base lug 16.

(Col. 5, lns. 15-43; see also FIGS. 2-3 and 5-6.)

Thus, it should be understood that it is the upright frame assembly 3 that is connected to the base assembly 2 using set screws and bushings. This is not what the claims require. The set screws and bushings discussed in Pavone only teach how to removably affix the frame member 3 to the base 2. They do not teach or suggest "a bushing received within an opening of

the mount, wherein the bushing is disposed between the mount and the mounting device" as in claim 11, "wherein the mount further includes a locking mechanism for arresting rotation of the mounting device within the opening" as in claim 12, or "wherein the locking mechanism is a set screw adapted to threadedly engage a hole in the mount and to engage the bushing" as in claim 13. (Emphasis added.) Thus, Pavone cannot remedy the deficiencies of Wood.

Even if one could import the teachings of Pavone into Wood, which applicants do not believe is the case, the combination would not have each and every element required by claims 11-13. Instead, at best, the pilaster or column 10 of Wood's display apparatus would be removably affixed to a freestanding base assembly. Also, there is no teaching or suggestion as to how Wood could be redesigned to incorporate the bushings and set screws of Pavone. Finally, it is not even clear that such a combination is feasible based upon the structure of Wood.

As to the second requirement, for the Examiner to meet his burden under 35 U.S.C. § 103(a) to reject, for example, claim 11, he must establish that one skilled in the art would be motivated to combine the teachings of Wood and Pavone. Neither reference provides such motivation. As acknowledged in the Office Action, Wood does not disclose either the bushing required by claim 11 or the locking mechanism required by claims 12-13. As stated above, one would have to physically alter the display apparatus of Wood to incorporate these additional components. The fact that a prior art process or device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). As stated in *In re*

Oetiker, 997 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992):

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

There is simply no teaching or motivation in the cited art to rebuild the Wood display apparatus using the components of Pavone in order to arrive at the wall mounting assemblies recited in claims 11-13.

In view of the foregoing, it is respectfully submitted that claims 11-13 patentably distinguishes over Wood and Pavone, both individually and in the combination, albeit improper, that the Examiner suggests can be made therefrom. Therefore, applicants respectfully request reconsideration and allowance of these claims.

Claims 1-10 and 14-28 were rejected as being anticipated by U.S. Patent Publication No. 2002/0056541 ("Kokubunji"). Claims 1, 14, 25 and 27 are independent. Applicants respectfully traverse the rejection.

Kokubunji discloses a mounting structure for a heat exchanger such as a radiator mounted in a vehicle. (See Abstract.) The rejection identifies various elements in Kokubunji as reading on each and every claim limitation. However, as will be explained below, Kokubunji itself and the elements identified therein are wholly unrelated to the claimed invention.

The Examiner asserts that Kokubunji includes "a mounting assembly adapted to engage a slat wall with a main body (210 and first and second arms 220) and a mount (211 or 212) attached to the main body and adapted to receive a mounting device." (Office Action at pg. 2.) According to Kokubunji,

"The present invention relates to a mounting structure for a heat exchanger, and a duplex heat exchanger. The present invention is suitable for mounting a heat exchanger, such as a radiator for cooling a vehicle engine or a condenser of a car air-conditioner, to a vehicle." (Published application, paragraph 0002.) There is no discussion whatsoever that the heat exchanger mounting structure is in any way capable of engaging a slat wall. *Kokubunji* goes on to state "reference numeral 211 denotes a plurality of aluminum radiator tubes (first tubes) through which cooling water flows, and reference numeral 212 denotes an aluminum radiator fin having a corrugated shape bonded to an outer surface of the radiator tubes 211 for enhancing the heat exchange between cooling water and air. A generally rectangular radiator core (first core) 210 for exchanging heat between cooling water and air is constituted by the radiator fin 212 and the radiator tubes 211." (Published application, paragraph 0026, emphasis added.) Thus, it should be clear that the radiator fin 212 and the radiator tubes 211 are the radiator core 210, and that none of these elements are the same or equivalent to the main body and mount of independent claims 1, 14, 25 and 27. In addition, *Kokubunji* states "Reference numeral 220 denotes a radiator tank (a first header tank) arranged at longitudinal opposite ends of the radiator tubes 211 and extending vertical to the longitudinal direction of the radiator tubes 211." (Published application, paragraph 0027.) The radiator tank 220 is simply not the first and second arms of the main body as required by claims 14 and 27.

In addition to the main body and the mount, independent claim 1 also requires "a first clip assembly attached to the main body and remote from the mount, the first clip assembly including an upper clip and a lower clip, the upper clip being engageable with the upper section of the slat wall, and the lower clip being engageable with the lower section of the slat wall; and a second clip assembly attached to the main body and remote from the mount, the second clip assembly including an upper clip and a lower clip, the upper clip being

engageable with the upper section of the slat wall, and the lower clip being engageable with the lower section of the slat wall; wherein the second clip assembly is spaced apart from the first clip assembly, and at least one of the upper clips or the lower clips of the first and second clip assemblies are adjustable." (Emphasis added.)

The main body of independent claim 14 requires "a central portion and first and second arms attached to the central portion, the first and second arms being operable to engage the slat wall, the central portion and the first and second arms defining a channel therebetween." As stated above, the radiator tank 220 is not the first and second arms required by claim 14. In addition to the main body and the mount, independent claim 14 also requires "a first clip assembly adjustably mounted to the first arm and engageable with the slat wall; and a second clip assembly adjustably mounted to the second arm and engageable with the slat wall; wherein the channel is so dimensioned that at least one cable of an electrical component supported by the mounting device is insertable through the channel between the main body and the slat wall." (Emphasis added.)

In addition to the main body and the mount, independent claim 25 also requires "a first fastening means attached to the main body, the first fastening means for securing the wall mounting assembly to the slat wall; and a second fastening means attached to the main body, the second fastening means for securing the wall mounting assembly to the slat wall; wherein the second fastening means is spaced apart from the first fastening means." (Emphasis added.)

The main body of independent claim 27 requires "a central portion and first and second arms attached to the central portion, the first and second arms being operable to engage the slat wall, the central portion and the first and second arms defining a channel therebetween." As stated above, the radiator tank 220 is not the first and second arms required by claim 27. In addition to the main body and the mount, independent claim 27 also requires "a first fastening means

associated with the first arm to secure the first arm to the slat wall; and a second fastening means associated with the second arm to secure the second arm to the slat wall; wherein the channel is so dimensioned that at least one cable of an electrical component supported by the mounting device is insertable through the channel between the main body and the slat wall." (Emphasis added.)

According to the Office Action, clips 300 are engageable with a slat wall. (See Office Action at pg. 2.) However, according to *Kokubunji*:

As shown in FIG. 1, brackets 300 are arranged at longitudinal opposite ends of the condenser tanks 120 and the radiator tanks 220, for mounting the radiator 200 and the condenser 100 to the vehicle. As shown in FIGS. 2A and 2B, the bracket 300 is coupled to the tank caps 121, 222 so that it is engaged with the tank caps 121, 222 by first and second U-shaped hooks 311, 312 (first and second fasteners) to be hooked to the arms 122b, 222b while pressing the latter from above and below, and by a recess 320 to be engaged with a projection 222c formed in the tank cap (in this embodiment, the cap body 222a of the radiator tank cap 222).

There are holes 122d, 222d and 331 in the first and second hooks 311, 312 and the arms 122b, 222b, through which bolts 330 (fastening means) are to be inserted. The bracket 300 is fixed to the tank caps 122, 222 by the bolts 330 after being engaged with the tank caps 122, 222 by the first and second hooks 311, 312 or others.

(Published Application, paragraphs 0037-38.)

There is simply no teaching or suggestion of connecting the heat exchanger mounting structure to a slat wall, or that it is even possible to do so. The first and second clip assemblies of claims 1 and 14 and the first and second fastening means of claims 25 and 27 are wholly different from the brackets of *Kokubunji*. In addition, as discussed above, the main body of independent claim 14 includes "a main body having a central portion and first and second arms attached to the central portion, the first and second arms being operable to engage the slat wall, the central portion and the first and second arms defining a channel therebetween." Claim 27 includes similar

limitations. As stated in a preferred embodiment of the invention, "The arms 204, 206 are spaced apart to form a recess or channel 224. (See FIGS. 3A, 3B and 3E.) The recess 224 provides cable management because the cable 302 and plug 304 connected to the electronic device 300 may be passed through the recess 220 between the main body section 202 and the slat wall 400. (See FIG. 1A.)" (Application at paragraph 0039.) As shown in claims 14 and 27, the arms are positioned on the main body to engage the slat wall using the first and second clip assemblies or the first and second fastening means. The channel is defined as between the central portion and the first and second arms.

The Office Action asserts that the "central portion and arms combine to form a channel therebetween (the recess between arms 220 due to the width 210) with the clips of the arms being angled away from the mount, and a cable could be inserted through the channel." (Office Action at pg. 3.) As discussed earlier, the radiator tank 220 is not the first and second arms of claims 14 and 27. Furthermore, there is simply no support for the assertion that a cable could be inserted through the "channel" between portions of the radiator tank 220, particularly in view of the condenser side plates 130 and the radiator side plate 230. As seen in FIG. 1, the condenser side plates 130 and the radiator side plate 230 span across the entire length of the mounting structure and would appear to prevent insertion of an electrical cable of an electrical component supported by the mounting device through a channel between the radiator core 210 and the vehicle.

Thus, for at least these reasons, *Kokubunji* neither teaches nor suggests each and every limitation of independent claims 1, 14, 25, and 27. Therefore, applicants respectfully request reconsideration and allowance of these claims. Claims 3-13, 15-24, 26 and 28 depend from claims 1, 14, 25 and 27, respectively, and contain all of the limitations thereof as well as other limitations that are neither disclosed nor suggested by

the prior art of record. Accordingly, applicants submit that the dependent claims are likewise patentable.

Claims 29-38 were rejected as being obvious over *Kokubunji* in view of U.S. Patent No. 4,386,500 ("*Sigafoose*"). Applicants respectfully traverse the rejection.

The Office Action states that *Kokubunji* "does not disclose the components of the mounting structure in a kit. *Sigafoose* discloses providing a kit with components for conversion and installation of a heat exchanger. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have provided the components of *Kokubunji et al.*, in a kit as taught by *Sigafoose*, for the purpose of simplifying conversion and installation of the system." (Office Action, pg. 4.)

Applicants respectfully submit that *Kokubunji* and *Sigafoose*, taken alone or in combination, neither disclose nor suggest the kit of wall mounting assembly components as required by claims 29-38. The deficiencies of *Kokubunji* have been extensively detailed above and will not be repeated below, although they apply equally to claims 29-38. Nonetheless, while *Kokubunji* does not disclose all of the components of the kits of claims 29-38, as will be demonstrated below, the Examiner's rejection should be withdrawn for two reasons: (1) the combination does not result in the claimed invention; and (2) there is no motivation to combine the references to arrive at the invention.

As to the first requirement, the technical teachings of *Kokubunji* and *Sigafoose* are such that their combination would not result in the claimed invention. As admitted in the Office Action, *Kokubunji* neither teaches nor suggests a kit of wall mounting assembly components.

Sigafoose discloses "a heat saving conversion unit for hot water heaters of conventional type consisting of a heat exchanger attachment together with appropriate connecting apparatus provided in kit form." (Abstract.) Furthermore, "This invention relates to apparatus for use with conventional type hot water heaters in order to use heat which is normally wasted from residential or commercial refrigeration, air conditioning, or heat pump systems." (Col. 1, lns. 8-12.) "The present invention includes a simple kit combination which may be provided to existing users of hot water heaters and heating/cooling systems for conversion of their present components to more efficient use without a lot of expensive additional equipment. Furthermore, the kit of the present invention permits ready and easy installation of the component elements thereof with existing conventional hot water heaters whether of the electric, gas, or oil fired type." (Col. 2, lns. 8-17.)

While *Sigafoose* discusses a conversion kit, the kit itself does not appear to include any of the components required by the claimed invention. The mere provision of a water heater conversion kit cannot remedy the deficiencies of *Kokubunji*.

Even if one could import the teachings of *Sigafoose* into *Kokubunji*, which applicants do not believe is the case, the combination would not have each and every element required by claims 29-38. For example, independent claim 29 includes sets of first and second fastening means that are selected depending upon the structure of the slat wall. At best, *Sigafoose* suggests to provide all of the parts of *Kokubunji* in kit form, and does not teach or suggest exchangeable fastening means selected based upon the type of wall the assembly is mounted to. Finally, it is not even clear that such a combination is feasible based upon the structure of *Kokubunji*.

As to the second requirement, for the Examiner to meet his burden under 35 U.S.C. § 103(a) to reject, for example,

claim 29 or claim 30, he must establish that one skilled in the art would be motivated to combine the teachings of *Kokubunji* and *Sigafoose*. Neither reference provides such motivation.

As an initial matter, in order to rely on *Sigafoose* in an obviousness rejection, it must be analogous art. See M.P.E.P. § 2141.01(a). "A reference is analogous if it is from the same field of endeavor as the invention...Similarity in the structure and function of the invention and the prior art is indicative that the prior art is within the inventor's field of endeavor...If a reference is outside the inventor's field of endeavor, it is still analogous art if the reference is 'reasonably pertinent to the problem the particular problem with which the inventor is involved.'" *State Contracting & Eng. v. Condotte America*, 346 F.3d 1057, 1069 (Fed. Cir. 2003) (quoting *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992)).

Here, *Sigafoose* is clearly not within the same field of endeavor as the claimed invention, which pertains to a "universal wall-mounting assembly attachable to different slat wall configurations." (Specification at paragraph 0001.) The structure and function of the components of the hot water heater conversion unit are wholly distinct from the components of the claimed wall mounting assembly kits. Furthermore, the problem to be solved by *Sigafoose* is not reasonably pertinent to the problems addressed by the claimed kits. As stated in independent claim 29, "the sets of first and second fastening means for attaching to the main body can be selected depending on the structure of the slat wall." (Emphasis added.) In contrast, *Sigafoose* states "A further object of the present invention is to provide conversion equipment and structure as needed for efficient energy conversion of waste heat to heat hot water which equipment is provided in kit form for easy installation by the average homeowner. The kit is supplied in a container having all of the required elements needed for such conversion and installation with existing heating and cooling

systems as common in the average house." (Col. 1, line 63 to col. 2, line 3.) Clearly, the problem to be solved in *Sigafoose* is not reasonably pertinent to the problems addressed in the kits of claims 29-38.

As acknowledged in the Office Action, *Kokubunji* does not disclose a kit of wall mounting assembly components required by claims 29-38. The fact that a prior art process or device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such modification. See the above discussion of *In re Gordon* and *In re Oetiker*.

There is simply no teaching or motivation in the cited art to provide the *Kokubunji* heat exchanger mounting apparatus in a kit. The components of *Sigafoose* are wholly dissimilar to the components of *Kokubunji* and to the claimed invention, and the problems solved by *Sigafoose* and the claimed invention are not reasonably related.

In view of the foregoing, it is respectfully submitted that claims 29-38 patentably distinguish over *Kokubunji* and *Sigafoose*, both individually and in the combination, albeit improper, that the Examiner suggests can be made therefrom. Therefore, applicants respectfully request reconsideration and allowance of these claims.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

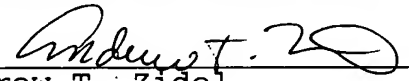
Application No.: 10/728,305

Docket No.: INNOFF 3.0-028

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 23, 2005

Respectfully submitted,

By 
Andrew T. Zidel
Registration No.: 45,256
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant

574581_1.DOC